

### **REMARKS**

Reconsideration of this application is respectfully requested. Claim 13 has been amended without prejudice or disclaimer to remove reference to A $\beta$  toxicity. Claim 18 has been canceled without prejudice. Amendment or cancelation of the claims was made solely for the purpose of responding to this office action and is not to be construed as surrender of any subject matter. Applicants hereby reserve the right to pursue the canceled or amended subject matter in one or more continuation or divisional applications. No new matter was added by virtue of these amendments and entry is respectfully requested. Claim 13 is pending and at issue.

Due to the finality of the Office Action, Applicants are filing herewith a Request for Continued Examination (RCE) and the appropriate fees.

### **Enablement Rejection**

Claims 13 and 18 remain rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. Applicants respectfully traverse.

According to the Examiner, the specification enables the treatment of A $\beta$  aggregation in the CNS, but it does not enable protection of all neurons in the CNS (*see* Office action, page 3). The Examiner contends that the working examples demonstrate that donepezil decreases the amount of A $\beta$  aggregation in cholinergic neurons, but there are no working examples that support completely preventing disorders in all neurons (Office action, pages 4-5). The Examiner concludes that undue experimentation would be required to practice the entire scope of the claimed invention, which includes completely preventing A $\beta$  toxicity.

According to the specification, “protection” of neurons is defined as providing a “protective effect upon neurons of the central nervous system against various loads resulted from ischemia-like effect” (*see* published specification at ¶155). As pointed out by the Examiner, protection of neurons is also defined as “not only to actually prevent the death of neurons of the central nervous system caused by loads on them (e.g., physical or chemical disorders undesirable for the maintenance of homeostasis, such as stress, trophopathy, diseases, injuries, decreased

strength due to surgical operations or the like, prostration, aging; or cytotoxicity), but also to prevent the lowering of functions of neurons" (*see* specification at ¶156).

Applicants submit that the Examiner improperly construes the claims based on an unduly broad definition of "protection." However, as noted above, the definition of "protection" in the specification only calls for preventing "cell death" and the "lowering of neuronal function." Therefore, "protection" does not mean "completely preventing [all] disorders" as alleged by the Examiner. Therefore, the working examples enable the claimed subject matter in view of this definition of "protection."

Although Applicants disagree with the Examiner's assertions, in order to compact and expedite prosecution, Applicants have amended claim 13 to delete reference to A $\beta$  toxicity and claim 18 was canceled without prejudice. Amendment or cancellation of the claims was made solely for the purpose of responding to this office action and is not to be construed as surrender of any subject matter. Applicants hereby reserve the right to pursue the canceled or amended subject matter in one or more continuation or divisional applications.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

### **Anticipation Rejection**

Claims 13 and 18 remain rejected under 35 U.S.C. § 102(b) as anticipated by Emilien, et al., *Arch. Neurol.*, 57:454-459 (2000), as evidenced by Michaelis, *JPET*, 304:897-904 (2003). The Examiner maintains that Emilien teaches that donepezil is an FDA-approved acetylcholinesterase [inhibitor] approved for treating Alzheimer's disease (AD). The Examiner again takes the position that treatment of neuron disorders induced by A $\beta$  toxicity is inherently taught by Emilien, and that Michaelis teaches that A $\beta$  plaques and A $\beta$  toxicity are associated with AD. Thus, the Examiner concludes that donepezil would necessarily treat A $\beta$  toxicity because it is known to treat AD and has been used previously in AD populations (*see* Office Action, pages 6-7). Applicants respectfully traverse.

In order to compact and expedite prosecution, claim 18 was canceled and claim 13 has been amended, without prejudice or disclaimer, to call for a method of protecting neurons of the central nervous system, comprising administering an effective amount of the recited compound to protect neurons of a patient in need thereof from damage induced by cerebral ischemia, or excitotoxicity, (*see* amended claim 13).

Emilien does not disclose or suggest a method of protecting neurons from ischemia, or excitotoxicity by administering the claimed compound. Emilien is merely a review article describing various approved, and not yet approved drugs relevant for treating Alzheimer's disease (as of 2000). Emilien describes donepezil as a piperidine-based AchE (acetylcholinesterase) inhibitor with specificity for AchE. Emilien is silent with regard to whether donepezil would necessarily protect neurons of a patient in need thereof from damage induced by cerebral ischemia, or excitotoxicity.

Anticipation requires that each and every element of the rejected claim(s) be disclosed in a single prior art reference. *See* MPEP § 2131 (8th Ed., Rev. 4, Jan. 2006). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Emilien provides no teachings regarding a method of protecting neurons of the central nervous system, comprising administering an effective amount of the recited compound to protect neurons of a patient in need thereof from damage induced by cerebral ischemia, or excitotoxicity.

In view of the remarks provided herein, Emilien fails to anticipate claim 13. Applicants respectfully request reconsideration and withdrawal of the instant rejection.

## **CONCLUSION**

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining that the Examiner believes can be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: March 11, 2009

Respectfully submitted,

By       Nicholas A. Zachariades        
Nicholas A. Zachariades  
Registration No.: 56,712  
DARBY & DARBY P.C.  
P.O. Box 770  
Church Street Station  
New York, New York 10008-0770  
(212) 527-7700  
(212) 527-7701 (Fax)  
Attorneys/Agents For Applicants